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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/182,033 10/29/98 BURNS

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TM02/0509

EXAMINER

KAZIMI, H

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

05/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/182,033

Applicant(s)
Burns

Examiner
Hani Kazimi

Art Unit
2164



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 21, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-49 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Oct 29, 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

1. This communication is in response to the amendment filed on February 21, 2001. The objections and rejections cited are as stated below:

Status of Claims

2. Of the original claims 1-22, claims 1, 2, 4, 5, 8, 9, 11, 12, 14, and 21 have been amended, and claims 23-29 have been added in the preliminary amendment filed on September 29, 1999. In the amendment filed on February 3, 2000, claims 1, 2, 4-9, 11-14, 18, 19, 21-24, and 29 have been amended. In the amendment filed on July 26, 2000, claims 1-29 have been canceled, and claims 30-39 have been added. In the amendment filed on February 21, 2001, claims 30, and 32 have been amended, and claims 40-49 have been added. Therefore, claims 30-49 are under prosecution in this application.

Summary of this Office Action

3. Applicants' arguments filed on February 21, 2001 have been fully considered, and discussed in the next section below or within the following rejection are not deemed to be persuasive. Therefore, claims 30-49 are rejected as being unpatentable over the art cited below, and Applicants' request for allowance is respectfully denied.

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Response to Applicants' Amendment

4. The Examiner acknowledges Applicant's amendment to claims 30, and 32 and therefore withdraws the previous office action's claim rejections under 35 U.S.C. § 112 2nd paragraph regarding this matter.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation “--- means for each consumer to enter unutilized coupon information from printed coupons is the *only* means provided ---” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Specification

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in the claims. The specification, as originally filed does not provide support for the invention as now claimed.

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The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

The Applicant has amended claims 30-39 to include the limitation “--- means for each consumer to enter unutilized coupon information from printed coupons is the *only* means provided ---” and added claims 40-49 containing the limitation “wherein consumers are *limited* to adding unutilized coupon information into their consumer account *solely* from printed coupons in their possession.”. However, the specification does not provide an enabling disclosure to support the claimed step of “one means to enter unutilized coupon information from printed coupons is the *only* means provided for consumers to add unutilized coupon information into their accounts”.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 30-49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 30-49 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 30-49 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claims 30, and 40, recite the limitations "-- the consumer's consumer identification means --", and "-- said consumer's consumer identification means --" respectively. There is insufficient antecedent basis for these limitations in the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 30-49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nichtberger et al. (U.S. Patent No. 4,882,675) hereinafter "Nichtberger" in view of De Lapa et al. (U.S. Patent No. 4,882,675) hereinafter "De Lapa".

Claims 30, and 40, Nichtberger teaches an electronic coupon processing system for eliminating a presentation of printed coupons at a checkout register (abstract) comprising:

a plurality of consumer identification means wherein each consumer identification is associated with a consumer (column 5, lines 1-16, and column 5, line 45 thru column 6, line 23);

a plurality of consumer accounts associated with said plurality of consumer identification means (column 11, lines 35-63, and column 17, line 49 thru column 18, line 43);

a database for storing information for each of said plurality of consumer accounts (column 29, lines 32-68);

at least one means separate from a checkout register for each consumer to enter unutilized coupon information from printed coupons in the consumer's possession into said associated

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consumer account based on input of the consumer's identification means so as to eliminate any need to present printed coupons at a checkout register (column 17, line 29 thru column 18, line 43);

at least one checkout register capable of collecting a consumer's purchase information, said register additionally being connected to said database (column 17, line 29 thru column 18, line 43);

means associated with said checkout register for reconciling the unutilized coupon information in each consumer's consumer account with the consumer's purchase information based solely on input of said consumer's consumer identification means (column 17, line 29 thru column 18, line 43); and

means for updating said consumer's consumer account to reflect utilization of coupons (column 17, line 29 thru column 18, line 43), wherein one means for each consumer to enter unutilized coupon information from printed coupons provided for consumers to add unutilized coupon information into their consumer account (column 29, lines 56-68).

Nichtberger fails to teach that the one means for each consumer to enter unutilized coupon information from printed coupons is the *only* means provided for consumers to add unutilized coupon information into their consumer account.

De Lapa teaches that the one means for each consumer to enter unutilized coupon information from printed coupons is the *only* means provided for consumers to add unutilized coupon information into their consumer account (column 9, line 32 thru column 12, line 34).

It would have been obvious to one of ordinary skilled in the art at the time the Applicant's

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invention was made to modify the teachings of Nichtberger to include that the one means for each consumer to enter unutilized coupon information from printed coupons is the *only* means provided for consumers to add unutilized coupon information into their consumer account, because it greatly improves the efficiency of the system by substantially reducing redemption and clearing costs, reducing fraud by destroying paper coupons by the CDR unit once inserted and read, also, it would integrate currently used system into the invention (see Nichtberger column 29, lines 56-68).

Claims 31, and 41, Nichtberger teaches the use of a consumer's frequent shopper card as a consumer identification means (abstract).

Claims 32, and 42, Nichtberger teaches that additional unutilized coupon information is added to a consumer account by the system based on market information collected for a consumer associated with said consumer account (column 18, lines 5-41, and column 28, line 51 thru column 29, line 68).

Claims 33, and 43, Nichtberger teaches that said database is connected to registers at a particular store or group of stores (fig. 1, and column 17, line 29 thru column 18, line 43, and column 29, lines 13-68).

Claims 34, and 44, Nichtberger teaches that at least one means for each of said plurality of

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consumers to enter unutilized coupon information from printed coupons in their possession consists of a scanner (column 29, lines 56-68).

Claims 35, and 45, Nichtberger teaches that said scanner is located in a store and said store further includes means for viewing and a printer for providing a printout of unutilized coupon information in a consumer's account based on input of a consumer's consumer identification means (fig. 1, column 5, lines 1-16, column 11, lines 35-63, and column 29, lines 13-68).

Claims 36, and 46, Nichtberger fails to teach that the printout includes an aisle location for products associated with said coupon information in said consumer account.

Official Notice is taken that printing an aisle location on a coupon is old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Nichtberger to include an aisle location for products associated with said coupon information in said consumer account, because it greatly improves the efficiency of the system by providing the consumer with a coupon that contains the product location in the store which saves the consumer time in locating the product.

Claims 37, and 47, Nichtberger teaches that said means for reconciling automatically sends both purchase information and coupon information directly to a clearinghouse or a manufacturer

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for reimbursement (column 17, line 48 thru column 18, line 41).

Claims 38, and 48, Nichtberger fails to teach the use of Internet to review unutilized coupon information in a consumer's account based on input of a consumer's consumer identification means.

Official Notice is taken that reviewing coupons through the Internet is old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Nichtberger to include the use of Internet to review unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means, because it provides convenience to the user by allowing the user to access various supermarket CDR units, and review, select, and retrieve coupon information directly from the operations center.

Claims 39, and 49, Nichtberger teaches the means to provide a printout of unutilized coupon information in a consumer's account (column 5, lines 1-16, and column 11, lines 35-63).

Response to Arguments

15. Applicant's arguments with respect to claims 30-49 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 2100 or this Art Unit is (703) 308-6296 or 6306.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Hani.Kazimi

May 3, 2001



**VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100**